

REMARKS

By this amendment, claims 16 and 17 are added and arguments are presented to place this application in condition for allowance. New claim 16 is added to ensure that the means for cover is considered to be a limitation of the claims since it appears that the Examiner may not be treating claim 1 to require such. Similarly, new claim 17 requires the combination of the incise film with the first fenestration.

Applicant requests reconsideration of the rejection of the claims and arguments in support of the patentability of the claims is presented below.

In review, each of independent claims 1 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,143,091 to Patnode et al. (Patnode). In taking this position, the Examiner alleges that the Patnode teaches a drape with a "first fenestration 28 and at least one further fenestration 29 which is capable of being used for the reception of a means of reference protruding from the level of the drape's surface which is identifiable for a 2- or 3- dimensional measurement system."

Applicants contend that Patnode does not teach the drape as claimed and a *prima facie* case of anticipation cannot be said to exist.

Applicants admit that Patnode does disclose a surgical drape with two fenestrations. However, the two fenestrations are not the same as the first and further fenestrations defined in claim 1.

Turning to claim 1, the first fenestration is for an incise film with or without a collection pouch. The question of anticipation is whether Patnode teaches a first fenestration for an incise film. There is nothing in Patnode that says that the

fenestration 28 is for an incise film. To the contrary, the fenestration 28 is designed for putting a leg through it as stated in col. 2, lines 50-55. The background art section of the present application clearly describes fenestrations for incise films, wherein the fenestration is designed to surround the area to be incised and the incise film is designed to cover the area and be adhered to the drape. From this, it is clear that the first fenestration for an incise film is not the same as the fenestration for a limb as is taught in Patnode. The failure of Patnode to teach the claimed first fenestration means that the rejection based on 35 U.S.C. § 102(b) must be withdrawn.

The rejection is also flawed since Patnode fails to teach the further fenestration for a reception of a means for cover for a reference means that protrudes from the level of the drape surface. The fenestration 29 of Patnode is also designed to allow a limb of a patient to pass through it. Therefore, this fenestration cannot be considered to be the claimed fenestration and anticipation cannot exist.

A further argument in support of the contention that the first and further fenestrations are not the same is that they are each designed not to allow a limb to pass therethrough. A fenestration for an incise film would inhibit the passing through of a limb as is required in Patnode. Similarly, the further fenestration for a means for cover of a means for reference would also inhibit the passing through of a limb. Thus, the fenestrations of Patnode cannot be considered to be the same as that claimed.

Applicants also contend that the Examiner cannot interpret claim 1 to be just a drape with two fenestrations since this ignores specific claim language as to the fenestrations themselves. The Examiner must read the fenestrations in the context

of the claim language and when doing so, it is clear that the drape of Patnode is not the same as that claimed.

Even if the Examiner were to insist that claim 1 is to be interpreted as a drape with the two fenestrations, new claim 16 requires the combination of the cover means and further fenestration. This combination is not found in Patnode for the simple reason that the two fenestrations are designed to allow a patient's limb to pass through and one of skill in the art would not include a means for cover over the fenestration since this would make the drape of Patnode inoperable for its intended purpose. The same argument also applies to claim 17.

In addition, the cover means is for a means of reference, which protrudes from the level of the drape's surface and which is identifiable for a 2- or 3-dimensional measurement system. This type of cover means is not taught or suggested in Patnode and this is further substantiation of the patentability of claims 1 and 16.

Applicants also submit that the Examiner cannot rely on 35 U.S.C. § 103(a) to allege that it would be obvious to modify Patnode and arrive at the invention. As explained above, Patnode's fenestrations are specifically designed for the passage of patient's limbs. Therefore, one of skill in the art would find no reason to alter these fenestrations such that they would be for an incise film and a cover means and a rejection of this nature would be based on hindsight and be unsustainable on appeal.

The rejection of claim 2 based on the combination of Patnode and United States Patent No. 5,490,524 to Williams et al. (Williams) is noted. However, Williams does not make up for the failings in Patnode and does not establish the obviousness

of combining a cover means with the drape of Patnode. The problem with the rejection of claim 2 is that the Examiner has mischaracterized the issue as just using a transparent cover means. The invention is not the use of a transparent cover means but the use of the transparent cover means for the 2- or 3- dimensional measurement system in combination with the further fenestration. The rejection fails to address the presence of the cover means to begin with so that the mere fact that Williams teaches a transparent cover means does not resolve the issue of patentability. Moreover, the fact that transparent cover means exists does not mean that it would be obvious to use them in the drape of Patnode since Patnode wants the fenestration to be open to allow passage of the patient's limb therethrough. The transparent cover means of Williams would interfere with this intention and there is no legitimate reason to look to Williams to modify Patnode.

In summary, Patnode alone or with Williams does not establish a *prima facie* case of anticipation against claim 1 since the two claimed fenestrations are not disclosed. Moreover, there is no basis to allege that Patnode alone or with Williams could be modified to include the claimed fenestrations since such a modification would render Patnode inoperable for its intended purposes.

Claims 16 and 17 are separately patentable over the prior art since the combination of the fenestrations and either cover means or incise film are not taught or suggested.

Since claim 1 is patentable over the prior art, its dependent claims are also in condition for allowance.

Accordingly, the Examiner is requested to examine this application and pass claims 1-17 onto issuance.

If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated December 10, 2008

Again, reconsideration and allowance of this application is respectfully requested.

A petition for a one month extension of time is made. Please charge Deposit Account No. 50-1088 the \$130.00 for the one month extension of time.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
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